



RECEIVED

DEC 05 2002

TECH CENTER 1600/2900

Attorney Docket No. LSB.0197.NPUS00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: WEI, ET AL.

SERIAL NO.: 09/864,637

FILED: MAY 23, 2001

TITLE: COLONY ARRAY-BASED CDNA  
LIBRARY NORMALIZATION BY  
HYBRIDIZATIONS COMPLEX RNA  
PROBES AND GENE SPECIFIC  
PROBES

EXAMINER: STRZELECKA,  
TERESA E.

ART UNIT: 1637

CONF. NO. 1716

Assistant Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

An Office Action was mailed in the above-captioned application on July 26, 2001. In such Office Action claims 1-36 were pending. Claims 1-36 were subject to a restriction and/or election requirement. This Response To Restriction Requirement document is submitted in response to said Office Action.

An election requirement was made to pending claims 1-36. The claims were placed into four groups:

Group I (claims 1-14) drawn to a method for constructing a normalized cDNA library of genes of low expression;

Group II (claims 15-31) drawn to a method for constructing a normalized cDNA library;

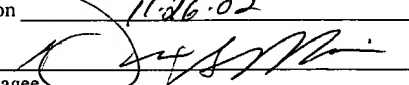
Group III (claim 32) drawn to method for constructing a normalized cDNA library of genes of low expression; and

Group IV (claims 33-36) drawn to normalized cDNA libraries.

37 CFR 1.8

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on 11/26/02

Signature:   
Name: Denise Magee

Applicant would like to thank the Examiner and the Examiner's supervisor for the courtesy extended in telephone conversations with the undersigned on November 22 and November 25, 2002 in which the restriction requirement was discussed. In these conversations, it was agreed that the restriction between Groups I, II, and III would be withdrawn based on the arguments presented below.

Applicant hereby provisionally elects to prosecute the claims of Group I, claims 1-14, with traverse.

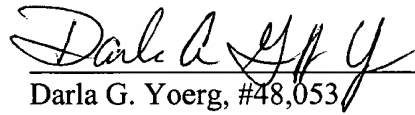
The Examiner asserts that Inventions I, II, and III are unrelated as the methods are directed to methods with different starting materials, method steps, and goals. If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP § 803. Applicant asserts that a *prima facie* case of serious burden on the Examiner has not been shown, and therefore, the restriction is improper. For purposes of the initial requirement, a serious burden on the Examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search. In the present case, the groups I, II, and III are classified in the same class and subclass: class 436, subclass 6. Additionally, the methods do use the same starting material, namely, "an RNA sample, wherein said RNA sample contains different species of RNA of different amounts." The goal of each of the claims in group I, II, and III is to construct a normalized cDNA library. Also, while the method steps are somewhat different for each of these three groups, the claims do contain some method steps in common. For example, Claims steps 1 (a) and (b), 15 (a), and 32 (a) are identical or highly analogous; claim steps 15 (b) and 32 (b) are identical or highly analogous; and Claim steps 1 (f), 15 (h), and 32 (c) are identical or highly analogous. Thus applicant submits that the inventions would not require a different field of search, or at the very least, that the fields of search are so overlapping as to not require any greater burden on the Examiner to search all three groups.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117, if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing

of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,

Date: November 26, 2002

A handwritten signature in cursive script, appearing to read "Darla G. Yoerg", is written over a horizontal line.

Darla G. Yoerg, #48,053  
Swanson & Bratschun, L.L.C.  
1745 Shea Center Drive, Suite 330  
Highlands Ranch, Colorado 80129  
Telephone: (303) 268-0066  
Facsimile: (303) 268-0065

S:\CLIENT FOLDERS\LARGE SCALE BIOLOGY\0197NPUS00\REST. REQ..DOC